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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/391,869	09/08/99	SMITH	M 83317/00004

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EXAMINER

THURSTON, A

ART UNIT

PAPER NUMBER

3722

3

DATE MAILED: 08/28/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/391,869

Applicant(s)
Mary Smith

Examiner
Alisa L. THURSTON

Group Art Unit
3722



☒ Responsive to communication(s) filed on Sep 8, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-31 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-31 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4, 6-9, 11, 12, 19, 22 and 26-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Friedman US Patent No. 5,042,841.

Friedman discloses the claimed invention including a method of binding a book and a book with a front cover and back cover and in between having pages and a pocket insert comprising a base sheet (14), with a binding edge (32) bound to the binding, and a pocket sheet (12) with a smaller width, but at least 60 percent of the base sheet and the perimeter of which is defined by an attached edge (18) to the base sheet and a free section (24) to form a pocket opening extending substantially parallel and facing the binding (see figure 2). Friedman also discloses the base sheet comprising a first edge (50), a second edge (18) opposed to the first edge and defining the binding edge and third and fourth edges (F3) opposed to one another and disposed between the first and second edges and defining the length of the base sheet and the pocket sheet with a first edge (F1) attached to the base sheet and a second edge opposed to the first edge and defining the width of

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the pocket sheet and a position of it attached to the base sheet (see figure 1) to form the pocket opening and third and fourth edges defining the length of the pocket sheet which has a shorter length than the base sheet and where the base sheet and the pocket sheet are formed of a single section of paper material

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 5, 10, 13-18, 20, 21, 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Friedman US Patent No. 5,042,841 in view of Lippeth et al US Patent No. 6,024,508. Friedman discloses the claimed invention as set forth in the above rejection in addition to attaching the base sheet to the pocket sheet with adhesive along the third and fourth edges. However, Friedman does not disclose the base sheet and the pocket sheet formed of separate sheets of paper material adhered to one another along the attached edge section, and along another long strip parallel to the third and fourth edges to separate the pockets to form two

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sheets, the base sheet formed of a length of about 11 inches and a width of 5 to 6 inches, and the multiple pages being 11 x 8.5 inches, and ~~diskettes~~ retained in the pockets.

Supp. media

It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the base sheet and the pocket sheet formed of separate sheets of paper material adhered to one another along the attached edge section, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179. Furthermore, the use of adhesive to attach two sheets together is widely known in the art. Therefore, it would have been obvious to attach the base sheet to the pocket sheet with adhesive along the edges in order to provide a bond between them to form a pocket.

It would have been an obvious matter of design choice to form the base sheet of a length of about 11 inches and a width of 5 to 6 inches, and the multiple pages being 11 x 8.5 inches, since such a modification would have involved a mere change in the size of a component, if necessary. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Lippeth teaches the use of a long strip parallel to third and fourth edges in order to create multiple pockets. Lippeth also discloses the use of these pockets for diskettes (column 4, lines 1-10). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use of a long strip parallel to third and fourth edges in order to create an

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additional pockets and to put diskettes in these pockets, as taught by Lippeth, in order to provide easy carrying means for multiple articles.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: US Des 384972, US 4519629, US 5125561, US 5513914, US 4577889, US 4084696, US 5378022, US 5316404, Des 363737, US 5236226, US 5141485, US 5839762, US 5795089, US 4824273

6. In order to reduce pendency and avoid potential delays, Group 3720 is encouraging FAXING of responses to Office Actions directly into the Group at (703) 305-3579.

Transmissions can be received from the Applicant at all times. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. The faxing of such documents must conform with the notice published in the official Gazette, 1096 OG 30 (October 19, 1998).

Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into Group 3720 will be promptly forwarded to the Examiner. Applicant is reminded to clearly mark any transmissions as "DRAFT" if it is not to be considered as an official response.


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7. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Alisa Thurston whose telephone number is (703) 305-1645. The examiner can normally be reached on Monday-Friday from 7:00 am to 4:00 pm. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, A. L. Wellington, can be reached on (703) 308-2159.

Any inquire of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1148.

ALT

August 14, 2000


A. L. WELLINGTON
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